

Application Serial No. 09/773,539

Attorney Docket No. 52493.000121

REMARKS

The January 6, 2005 Office Action has been reviewed and its contents carefully considered. Claims 1-16 and 19-21 are pending in the present application. By this amendment, claims 12-16, and 19 are amended and claims 17 and 18 are canceled without prejudice or disclaimer to the subject matter set forth therein. Claim 19 is amended to address a minor deficiency. No new matter has been added by this amendment.

For the reasons set forth below, the claims are believed to be in condition for allowance.

I. The Rejection under 35 U.S.C. §101

In the Office Action, claims 12-16 and 18 are rejected under 35 U.S.C. 101 asserting the claimed invention is directed to non-statutory subject matter. The Office Action asserts the basis of this rejection is set forth in a two-prong test of: (1) whether the invention is within the technological arts; and (2) whether the invention produces a useful, concrete, and tangible result. The Office Action asserts for a claimed invention to be statutory, the claimed invention must be within the technological arts, and that mere ideas in the abstract that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" and therefore are found to be non-statutory subject matter. The Office Action reflects for a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

The Office Action asserts that in the present case, claims 12 -16 and 18 only recite an abstract idea, and that claims 12 - 16 and 18 do not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use a pencil and paper. The Office Action further asserts that although the recited process produces

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a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claims 12 - 16 and 18 are deemed to be directed to non-statutory subject matter.

By this Amendment, claim 18 is canceled, thus obviating the rejection as to claim 18.

As to claim 12, Applicant respectfully traverses the rejection and submits that the rejection under 35 U.S.C. § 101 is misplaced. It is well established that §101 requires (1) the invention have utility or operativeness and (2) the invention falls within one of the proper subject matter categories (process, machine, article of manufacture, and composition of matter).

The Examiner's rejection does not claim that the present invention has no utility - which it clearly does. Regarding subject matter category, the invention of each of the claims is recited as a "method," which plainly falls within the ambit of the "process" category set forth in §101.

MPEP §706.03(a) provides no support for the rejection set forth in the Office Action. MPEP §706.03(a) provides that rejections under §101 may be made for the following reasons: nonstatutory subject matter (printed matter, naturally occurring article, scientific principle), lack of utility, and inoperativeness. None of these apply here. Applicant is unaware of any requirement imposed by the Patent Statute or controlling precedent requiring an Applicant to recite structure in a method claim.

However, in response to the Examiner's comments and in order to expedite prosecution of this application, Applicant has amended the preamble of claim 12 to recite a "computer implemented method". Dependent claims 13-16 have been similarly amended. Support for the amendments may be found in the drawings of the present application, for example.

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Applicant submits that such amendments to the claims moots the issue regarding §101. A method implemented with a computer clearly recites "technology." Applicant submits that the claims clearly now recite "technology" and requests that the §101 rejection be withdrawn.

II. THE CLAIMS DEFINE PATENTABLE SUBJECT MATTER

A. The Rejection based on the teachings of Landry and Kelliher

In the Office Action, claims 1, 3 - 4, 6, 8 -12 and 14 -16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Landry (U.S. Patent 5,956,700) in view of Kelliher (U.S. Patent 5,857,194). This rejection is respectfully traversed.

The Office Action asserts various teachings of Landry and Kelliher. In particular, on page 5, the Office Action asserts that Landry does not teach that the data storage also includes a representation of information as maintained by a retired system previously used for administering the financial program. The Office Action asserts that Kelliher discloses the retrieval of information (data) as maintained by a retired (legacy) system previously used for administering the financial program, and notes Kelliher's teaching of the Kelliher invention "analyses an existing legacy system, such as a Physician's Office Management System, and automatically extracts, reformats, and sends required data to a service company, which may be for example, an insurance company." The Office Action concludes that it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Landry by incorporating the ability to retrieve information from a retired system, as was done by Kelliher, to allow for easy integration of a new debit system to an existing insurance and billing information source. Applicant respectfully traverse such rejection and the assertions in the Office Action as a mischaracterization of the teachings of the applied art.

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Claim 1, set forth above, recites various features. In particular, claim 1 recites a system for administering a financial program involving the collection of payments, comprising: a debit system for coordinating the administration of the financial program, and a data storage for storing data tables used by the debit system in the administration of the financial program, the data storage also including a representation of information as maintained by a retired system previously used for administering the financial program. Accordingly, claim 1 is clearly directed to a system for administering a financial program involving the collection of payments, in conjunction with a representation of information (in the data storage of the system for administering a financial program) as maintained by a retired system previously used for administering the financial program. Thus, both the claimed system for administering the financial program AND the retired system are associated with the "financial program". The applied art fails to teach this claimed interrelationship.

To explain, Landry is directed to a system and method for paying bills and other obligations including selective payor and payee controls. In the Abstract, Landry describes a system for paying bills without requiring interaction with the payors disclosed. Landry teaches the system includes a payor control interface, a communications interface, a bill generator, and a TCF message generator. The bill generator generates bill records from payor and payee information stored within the system for recurring bills. The bill generator may also generate bill records from the payor and payee information and from bill data messages received from payees. The generated bill records are used by the TCF message generator to generate the EFT messages for transferring funds electronically between payors and payees.

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In contrast to the teachings of Landry, Kelliher is directed to automatic transmission of legacy system data. In the Abstract (and as referenced in the Office Action), Kelliher teaches the Kelliher invention analyses an existing legacy system, such as a physician's office management system, and automatically extracts, reformats and sends required data to a service company, which may be for example, and insurance company. Kelliher further teaches it begins by feeding the legacy system "seed data" and monitors the legacy system storage device to determine a "raw map" of where and how the seed data is stored. It then culls out multiple records, single records, inconsistent records in the raw map. Control flow information is also extracted. This indicates which fields are "key" fields and are used to extract other information. These key fields must be acquired before their related data. After the data is located and the order is determined, a script is automatically created to extract the data. Kelliher further teaches the data is then extracted and reformatted in a predetermined format determined by the service company, and the required data is automatically sent, by conventional means, to the service company.

Accordingly, Kelliher teaches the extraction of data from a *physician's office management system* and sending the data to a *service company*, for example. Accordingly, Kelliher fails to teach the claimed interrelationship of a system for administering a financial program and the retired system previously used for administering the financial program, and the claimed representation of information. In other words, the claimed invention might be characterized as the presently used system and the retired system have been used to administer the financial program. Kelliher, either alone or in combination with Landry, is devoid of such interrelationship and such features. Accordingly, Applicant submits that the applied art cannot

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be fairly combined, so as to teach or suggest the claimed invention as recited in claim 1, in that neither Landry nor Kelliher teach such features.

Further, Applicant further submits that it would not have been obvious to combine the applied art as alleged in the Office Action so as to attempt to teach the claimed invention. That is, the Office Action provides the motivation that it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Landry by incorporating the ability to retrieve information from a retired system, as was done by Kelliher, to allow for easy integration of a new debit system to an existing insurance and billing information source. Such assertions reflect a teaching of a new debit system and implicitly reflect an old debit system, which constitutes a fundamental teaching that the applied art simply does not suggest.

Alternatively, it is not seen where the art suggests the generation of any such new debit system.

That is, Kelliher teaches the extraction of data from a *physician's office management system* and sending the data to a *service company*. Such two respective systems are not used to administer a single financial program. For example, in column 1, lines 18-21, Kelliher teaches the Kelliher invention relates to electronic data transmission, and more specifically a system which automatically finds and transmits information to a service provider in one of a number of standard formats. Further, in column 2, lines 44-51, Kelliher teaches an object of the Kelliher invention is to provide a system that determines the data format of an existing system, extracts the data, and transmits the data in a required format; and that it is another object of the Kelliher invention to provide an automatic interface to transmit data from an existing computer systems to a remote computer system in one of several standard formats. However, these teachings are fundamentally different from the system as recited in the claimed invention, for the reasons set

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forth above. Accordingly, Applicant submits that Landry and Kelliher, either alone or in combination, fail to teach or suggest the claimed invention.

Applicant submits that claim 1 recites patentable subject matter at least for the reasons set forth above. Claim 12 recites patentable subject matter at least for reasons similar to claim 1. Further, the various dependent claims recite patentable subject matter at least based on their dependencies on the respective independent claims, as well as the additional features such dependent claims recite.

Withdrawal of the rejection under 35 U.S.C. §103 based on the teachings of Landry and Kelliher is respectfully requested.

B. The Rejection based on the teachings of Landry and Kelliher and Ryan

In the Office Action, claims 2, 5, 7, 13 and 17 - 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Landry in view of Kelliher, and further in view of Ryan (U.S. Patent 5,655,085).

The Office Action proposes to further modify the proposed combination of Landry and Kelliher with the teachings of Ryan. In particular, the Office Action asserts that it would have been obvious to the one of ordinary skill to incorporate the ability to handle other traditional insurance functions, as was done by Ryan, to further integrate multiple insurance functions into one insurance system. However, it is submitted that such modification of the Landry and Kelliher combination would fail to cure the deficiencies of the applied art as discussed above with respect to claim 1.

Accordingly, Applicant submits that claim 1 recites patentable subject matter at least for the reasons set forth above. Claim 19 recites patentable subject matter at least for reasons similar

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to claim 1. Further, the various dependent claims recite patentable subject matter at least based on their dependencies on the respective independent claims, as well as the additional features such dependent claims recite.

III. CONCLUSION

Applicant has reviewed the various grounds of rejection as set forth in the Office Action. It is respectfully submitted that the applied art fails to teach or suggest the claimed invention for the reasons set forth above.

Applicant respectfully submits that the application, as amended, is in condition for allowance. If the Examiner believes that prosecution might be advanced by discussing the application with Applicants' counsel, in person or over the telephone, we would welcome the opportunity to do so.

In the event any fees are due, the Commissioner is hereby authorized to charge the undersigned's Deposit Account No. 50-0206.

Respectfully submitted,

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